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PTO/SB/05 (11-00)

Approved for use through 10/31/2002. OMB 0651-0032

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# UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.	30426.1USD1
First Inventor	Han Htun, et al.
Title	METHOD AND COMPOSITIONS FOR MONITORING DNA BINDING MOLECULES IN LIVING CELLS
Express Mail Label No.	ET528312316US

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

- ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
- ☒ Applicant claims small entity status.  
See 37 CFR 1.27.
- ☒ Specification [Total Pages **89**]  
(preferred arrangement set forth below)
  - Descriptive title of the invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
- ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets **5**]
- Oath or Declaration [Total Pages **6**]
  - ☐ Newly executed (original or copy)  
Copy from a prior application (37 CFR 1.63 (d))  
(for continuation/divisional with Box 18 completed)
  - ☒ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s)  
named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
- ☒ Application Data Sheet. See 37 CFR 1.76

ADDRESS TO: Assistant Commissioner for Patents  
Box Patent Application  
Washington, DC 20231

- ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
- Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
  - ☐ Computer Readable Form (CRF)
  - Specification Sequence Listing on:
    - ☐ CD-ROM or CD-R (2 copies); or
    - ☐ paper
  - ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

- ☐ Assignment Papers (cover sheet & document(s))
- ☐ 37 CFR 3.73(b) Statement of Attorney (when there is an assignee)
- ☐ English Translation Document (if applicable)
- ☐ Information Disclosure Statement (IDS)/PTO-1449
- ☒ Preliminary Amendment
- ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
- ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
- ☐ Request and Certification under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
- ☒ Other: Transmittal sheet, in duplicate....  
Petition of Time.....

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP)

of prior application No.: **09 / 091,042**

Prior application information:

Examiner **Bradley L. Sisson**

Group Art Unit: **1655**

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

<input type="checkbox"/> Customer Number or Bar Code Label	<b>26,941</b>	or	<input type="checkbox"/> Correspondence address below
Name			
Address			
City	State	Zip Code	
Country	Telephone	Fax	

Name (Print/Type)	<b>Sarah B. Adriano</b>	Registration No. (Attorney/Agent)	<b>34,470</b>
Signature	<i>Sarah B. Adriano</i>	Date	<b>11/15/01</b>

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

11046 U.S. PTO  
10/00/1486

11/15/01

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**FEE TRANSMITTAL  
for FY 2002**

Patent fees are subject to annual revision.

**TOTAL AMOUNT OF PAYMENT** (\$) **370.00****Complete if Known**

Application Number	Not yet known
Filing Date	11/15/2001
First Named Inventor	Han Htun, et al.
Examiner Name	Bradley L. Sisson
Group Art Unit	1655
Attorney Docket No.	30426.1USD1

**METHOD OF PAYMENT**

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number	
Deposit Account Name	

☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17☒ Applicant claims small entity status. See 37 CFR 1.27

- 2.
- ☒
- Payment Enclosed:

☒ Check ☐ Credit card ☐ Money Order ☐ Other**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	370.00
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

**SUBTOTAL (1)** (\$) **370.00****2. EXTRA CLAIM FEES**

Total Claims	Extra Claims	Fee from below	Fee Paid
3	-20** = 0	9.00	0.00
1	-3** = 0	42.00	0.00
Multiple Dependent		140.00	0.00

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

**SUBTOTAL (2)** (\$) **0.00**

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1 17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1 129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** (\$) **0.00****SUBMITTED BY**

Complete (if applicable)

Name (Print/Type)	Sarah B. Adriano	Registration No. (Attorney/Agent)	34,470	Telephone	626-395-7801
Signature	<i>Sarah B. Adriano</i>	Date	11/15/01		

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

DOCKET NUMBER	ANTICIPATED CLASSIFICATION OF THIS APPLICATION:		PRIOR APPLICATION	
	CLASS	SUBCLASS	EXAMINER	ART UNIT
30426.1USD1	Unknown	Unknown	Bradley L. Sisson	1655

**CERTIFICATE UNDER 37 CFR 1.10:**

"Express Mail" mailing label number: ET528312316US  
Date of Deposit: November 15, 2001

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

By:   
Name: Tracy Truick

**DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)**

Assistant Commissioner for Patents  
Washington, DC 20231

Dear Sir:

This is a request for filing a continuation application under 37 CFR § 1.53(b) of Serial No. 09/091,042, filed on February 12, 1999 entitled METHOD AND COMPOSITIONS FOR MONITORING DNA BINDING MOLECULES IN LIVING CELLS by the following inventor(s):

Full Name Of Inventor	Family Name	First Given Name	Second Given Name
Residence & Citizenship	City	State or Foreign Country	Country of Citizenship
Post Office Address	Post Office Address	City	State & Zip Code/Country
Full Name Of Inventor	Family Name	First Given Name	Second Given Name
Residence & Citizenship	City	State or Foreign Country	Country of Citizenship
Post Office Address	Post Office Address	City	State & Zip Code/Country

- ☒ Enclosed is a true and correct copy of the prior application; including the specification, claims, drawings, oath or declaration showing the applicant's signature, and any amendments referred to in the oath or declaration filed to complete the prior application. (It is noted that no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein.) The copy of the prior application is as follows: 79 pages of specification, 9 pages of claims, 1 pages of abstract, 5 sheets of drawings and 6 pages of declarations.
- ☒ Cancel in this application original claims 1-15 and 19-58 of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
- ☒ The filing fee is calculated below:

**CLAIMS AS FILED**

NUMBER FILED	NUMBER EXTRA		RATE	FEE
<b>TOTAL CLAIMS:</b> 3                      -20	0	x	\$18.00	\$0.00
<b>INDEPENDENT CLAIMS</b> 1                      -3	0	x	\$80.00	\$0.00
			<b>BASIC FILING FEE:</b>	<b>\$370.00</b>
			<b>MULTIPLE DEPENDENT FEE:</b>	<b>\$0.00</b>
			<b>TOTAL FILING FEE:</b>	<b>\$370.00</b>

☒ Applicants claim small entity.

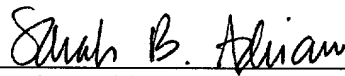
4. ☒ Payment of fees:  
☒ Attached is a check in the amount of \$370.00 filing fee.  
☐ Please charge Deposit Account No. 50-0306.
5. ☒ The Commissioner is hereby authorized to charge any additional fees as set forth in 37 CFR §§ 1.16 to 1.18 which may be required by this paper or credit any overpayment to Account No. 50-0306.
6. ☒ Amend the specification by inserting before the first line the sentence:  

"This application is a Divisional application of U.S. Serial No. 09/091,042, filed February 12, 1999, which is based on PCT/US96/19516 filed December 6, 1996. This application further claims the benefit of the filing date of U.S. Serial No. 60/008,373, filed December 8, 1995. The contents of all the foregoing applications are incorporated by reference into the present application."
7. ☐ A set of formal drawings (\_\_\_\_ sheets) is enclosed.
8. ☐ Priority of application Serial No. \_\_\_\_\_, filed on \_\_\_\_\_ in \_\_\_\_\_, is claimed under 35 U.S.C. 119.
- ☐ The certified copy has been filed in prior application Serial No. \_\_\_\_\_, filed \_\_\_\_\_.
9. ☒ The prior application is assigned of record to The Government of the United States of America, represented by The Secretary, Department of Health and Human Services, c/o National Institutes of Health.
10. ☒ The Power of Attorney in the prior application is to:  

NEEDLE & ROSENBERG, P.C.  
127 Peachtree Street, N.E., Suite 1200  
Atlanta, GA 30303
11. ☒ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)
- ☐ Fee for excess claims is attached.
12. ☒ A petition and fee has been filed to extend the term in the prior application until March 6, 2002. A copy of the petition for extension of time in the prior application is attached.

13. ☐ The inventor(s) in this application are less than those named in the prior application and it is requested that the following inventors identified above for the prior application be deleted:
14. ☒ Also Enclosed: Utility Patent Application Transmittal and Fee Transmittal for FY 2001, both in duplicate; Petition for Extension of Time and fee
15. ☒ Address all future communications to the **Attention of Sarah B. Adriano** (may only be completed by attorney or agent of record) at the address below.
16. ☒ A return postcard is enclosed.

Respectfully submitted,



Sarah B. Adriano  
Attorney for Applicants  
Mandel & Adriano  
35 No. Arroyo Parkway, Suite 60  
Pasadena, California 91103  
626/395-7801  
Customer No. 26,941

001103 626/395-7801 26,941

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant:** Han Htun, et al.  
**Serial No.:** 09/091,042  
**Filed:** February 12, 1999  
**Docket:** 30426.1USWO  
**Title:** METHOD AND COMPOSITIONS FOR MONITORING DNA BINDING MOLECULES IN LIVING CELLS

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CERTIFICATE UNDER 37 CFR 1.8

I hereby certify that this paper or fee is being deposited with the United States Postal as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on November 15, 2001.

By:   
Name: Tracy T. Prick

35 N. Arroyo Parkway, Suite 60  
Pasadena, California 91103  
November 15, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing Certificate under 37 CFR 1.8.
- ☒ Petition for 3 Month Extension of Time

Please charge any additional fees or credit overpayment to Deposit Account No. 50-0306. A duplicate of this sheet is enclosed.

**MANDEL & ADRIANO**

35 N. Arroyo Parkway, Suite 60  
Pasadena, California 91103  
(626) 395-7801

By: 

Name: Sarah B. Adriano  
Reg. No.: 34,470  
Initials: SBA  
Customer No. 26,941

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Han Htun, et al.  
**Serial No.:** 09/091,042  
**Filed:** February 12, 1999  
**Docket:** 30426.1USWO  
**Title:** METHOD AND COMPOSITIONS FOR MONITORING DNA BINDING MOLECULES IN LIVING CELLS

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**CERTIFICATE UNDER 37 CFR 1.8**

I hereby certify that this paper or fee is being deposited with the United States Postal as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on November 15, 2001.

By:   
Name: Tracy Prick

35 N. Arroyo Parkway, Suite 60  
Pasadena, California 91103  
November 15, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

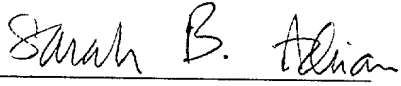
We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing Certificate under 37 CFR 1.8.
- ☒ Petition for 3 Month Extension of Time

Please charge any additional fees or credit overpayment to Deposit Account No. 50-0306. A duplicate of this sheet is enclosed.

**MANDEL & ADRIANO**

35 N. Arroyo Parkway, Suite 60  
Pasadena, California 91103  
(626) 395-7801

By:   
Name: Sarah B. Adriano  
Reg. No.: 34,470  
Initials: SBA  
Customer No. 26,941